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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/825,584

04/04/2001

Robert Akita

P1003R1C1D1

3718

7590

11/17/2005

Attn: Wendy M. Lee

Genentech; Inc.

1 DNA Way

South San Francisco, CA 94080-4990

EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1643

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,584	AKITA ET AL.	
	Examiner	Art Unit	
	Christopher H. Yaen	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RE: AKITA *et al*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Accordingly, the amendment filed 2/4/2005 is entered into the record.
2. Claims 1-33, and 40-51 are canceled without prejudice or disclaimer.
3. Claims 34-39 are pending and examined on the merits.

New Arguments

Claim Rejections - 35 USC § 112, 1st paragraph

4. Claims 34-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The following written description rejection is set forth herein.

Vas-Cath Inc. V. Mahurkar, 19 USPQ2d 1111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116). Applicant is

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reminded that *Vas-Cath* makes clear that the written description provision of 35 USC 112 is severable from its enablement provision (see page 115).

The claims are drawn to an antibody that “binds to an epitope bound by the 8B8 antibody” which has been deposited with the ATCC under ATCC HB-12070.

The specification does not describe with any degree of particularity a single member of the genus of antibodies that “bind to an epitope bound by the 8B8 antibody” to which the members of the claimed genus of antibodies must bind, such that the specification might reasonably convey to the skilled artisan that Applicant had possession of the claimed invention at the time the application was filed. At paragraph [0213], the specification describes the production of antibodies that bind to the ErbB3 protein and indicate that amino acids 26-53 of the extracellular domain is used for the production and generation of an antibody. However, no information is given regarding the “epitope bound by the 8B8 antibody” as claimed, such that one skilled in the art could not immediately recognize or distinguish members of the genus of claimed antibodies capable of binding such an epitope, because one could not immediately recognize or distinguish members of the genus to which the members of the claimed genus of antibodies must bind.

The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, “Written Description” Requirement (66 FR 1099-1111, January 5, 2001) state, “[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing the invention was ‘ready for patenting’ such as by disclosure of drawings or structural chemical formulas that show that the invention was

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complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (*Id.* at 1104). Moreover, because the claims encompass a genus of variant species, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that Applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by Applicant in the specification; nor has Applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has Applicant described distinguishing identifying characteristics sufficient to show that Applicant were in possession of the claimed invention at the time the application was filed.

As evidenced by Greenspan et al. (*Nature Biotechnology* 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an "epitope" (page 937, column 2). According to Greenspan et al., an epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows the epitope to which any given antibody binds can only be identified

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empirically. Even using a competition assay, the skilled artisan cannot determine whether an antibody binds the same epitope as another antibody because an antibody that competes with another does not necessarily bind the same epitope as the other; rather, one antibody may bind a spatially overlapping epitope to sterically hinder binding of the other. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of epitopes to which the members of the claimed genus of antibodies must bind, the skilled artisan could not immediately recognize or distinguish members of the claimed genus of antibodies. Moreover, since the specification has not identified which amino acids of the genus of epitopes to which the 8B8 antibody is to bind, which are critical or essential to the binding, one skilled in the art would not recognize that Applicant had possession of the claimed invention at the time the application was filed.

All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in a paper filed on 2/4/2005.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on 571-272-0832. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen
Art Unit 1643
October 31, 2005


CHRISTOPHER YAEN
PATENT EXAMINER